

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

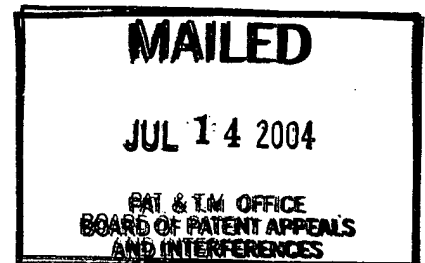
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM PATRICK APPS

Appeal No. 2004-1356
Application 09/785,100

ON BRIEF



Before KIMLIN, PAK, and TIMM, Administrative Patent Judges.

PAK, Administrative Patent Judge.

REMAND TO THE EXAMINER

This case is not ripe for meaningful review and is, therefore, remanded to the examiner for appropriate action consistent with the views expressed below.

The examiner stated at page 4 of the Answer that:

Claims 1-51 are rejected under 35 U.S.C. [§] 102(e) as being anticipated by Apps et al. (5,651,461) (Apps '461). This rejection is set forth in prior Office action, Paper No. 15.

Claims 15-19, 21-26, 50 and 51 are rejected under 35 U.S.C. [§] 102(e) as being anticipated by Apps et al. (5,704,482) (Apps '482). This rejection is set

forth in prior Office Action, Paper No. 15.

Claims 28-30 and 32-39 are rejected under 35 U.S.C. [§] 102(b) and/or (e) as being anticipated by Koefeldt et al. (5,465,843). This rejection is set forth in prior Office Action, Paper No. 15.

Claims 1-51 are rejected under the judicially created doctrine of [obviousness-type] double patenting over claims 1-5 of U.S. Patent No. 5,979,654 to Apps (Apps '654). This rejection is set forth in prior Office Action, Paper No. 15.

Claims 1-51 are rejected under the judicially created doctrine of [obviousness-type] double patenting over figures 1-12 [included in the claim] of U.S. Patent No. D400,012 to Apps (Apps '012). This rejection is set forth in prior Office Action, Paper No. 15.

The prior Office action referred to by the examiner, however, does not indicate what features disclosed in Apps '461, Apps '482 and Koefeldt correspond to the claimed features¹ and where in Apps '461, Apps '482 and Koefeldt can such corresponding features be found (indicate specific columns and lines of the prior art involved). The prior Office action also does not indicate what features claimed in Apps '654 or Apps '012 correspond to the features recited in claims 1 and 15 and why the claimed features

¹ According to the appellant (Brief, page 6), the claims on appeal are grouped as follows:

- Group 1 - Claims 1, 3-14, 20, 27, 31 and 40-49;
- Group 2 - Claim 2;
- Group 3 - Claims 15, 17-19, 21-26, 50 and 51;
- Group 4 - Claim 16;
- Group 5 - Claims 28-30, 32, 34-39; and
- Group 6 - Claim 33.

Therefore, for purposes of this appeal, the examiner may limit his or her findings relating to the Section 102 rejections to representative claims 1, 2, 15, 16, 28 and 33 pursuant to 37 CFR § 1.192(c) (7) (2003).

Appeal No. 2004-1356
Application No. 09/785,100

missing, if any, in the claims of Apps '654 or '012, would have been obvious to one of ordinary skill in the art. The examiner provided no obviousness analysis for the obviousness-type double patenting rejections set forth in the prior Office Action and the Answer. The examiner also did not respond to the appellants' argument regarding the "two-way" obviousness test for the obviousness-type double patenting rejection based on Apps '012 in the prior Office Action and the Answer.


In view of the above deficiencies in the Answer, we remand this application to the examiner to authorize the submission of a Supplemental Examiner's Answer addressing the above deficiencies pursuant to 37 CFR § 1.193(b)(1)(2003).

This application, by virtue of its "special" status, requires immediate action. See MPEP § 708.01(d) (8th Ed., Rev. 1, Feb. 2003). It is important that the Board of Patent Appeals and

Appeal No. 2004-1356
Application No. 09/785,100


Interferences be informed promptly of any action affecting the appeal in this case. See *MPEP* § 1211 (8th Ed., Rev. 1, Feb 2003).

REMANDED


EDWARD C. KIMLIN
Administrative Patent Judge

CHUNG R. PAK
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INTERFERENCES


CATHERINE TIMM
Administrative Patent Judge

CKP: dal

Appeal No. 2004-1356
Application No. 09/785,100

KONSTANTINE J. DIAMOND
4010 E. 26TH STREET
LOS ANGELES CA 90023